

Application No: 09/773,156
Attorney's Docket No: PHNL 000031

REMARKS

Applicant acknowledges receipt of the Office Action dated 03/14/2006. Claims 1-12 were pending in the application and are presented for reconsideration and further examination in view of the following remarks and arguments.

By this Response and Amendment claims 1, 6, 11 and 12 are amended to clarify what Applicant regards as their invention, without changing the intended scope of the claims; and the rejection of claims 1-12 under 35 U.S.C. § 103(a) is respectfully traversed.

Rejections under 35 U.S.C. § 103

The Examiner rejected claims 1-12 under 35 U.S.C. § 103(a) as being obvious over US Patent 5,485,279 to Yonemitsu, hereinafter noted "Yonemitsu," in view of US Patent 5,543,925 to Timmermans, hereinafter noted "Timmermans."

Applicant respectfully traverses these rejections.

Independent claims 1, 6, 11 and 12 are directed to a video encoder and a corresponding method of encoding images, and a video decoder and a corresponding method of decoding images. As recited in representative claim 1, the video encoder comprises a memory for storing a reference image with a first resolution, and for also storing two reference images with a second, lower resolution.

To establish a *prima facie* case of obviousness, three basic criteria must be met.

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First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaack*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP § 2143-§2143.03 for decisions pertinent to each of these criteria.

Applicant respectfully submits that the Examiner has not established a *prima facie* case of obviousness because the prior art references cited by the Examiner do not teach or suggest all the claim limitations, as recited in independent claims 1, 6, 11 and 12, or in any of their respective dependent claims.

The combination of Yonemitsu and Timmermans does not teach or suggest "a memory for storing said reference image with said first resolution," and "also storing said two reference images with the second resolution in said memory," as recited in, e.g., claim 1. In the Office Action, the Examiner admits that "Yonemitsu does not specifically disclose the memory for storing reference images in both first and second resolutions" and relies upon Timmermans for that feature. However, Applicant submits that, contrary to the Examiner's assertion, Timmermans does not teach or suggest that feature either.

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What Timmermans discloses is a set of subfiles, representing the same digitized picture at different resolutions, stored on a digital data base medium, i.e. a record carrier such as a Compact Disc. *See* Figs. 1a-1b, Col. 4:25-30, Col. 5:62-64, Col. 6:11-14, Col. 7:8-13, Col. 7:35-52, Claim 1 and Claim 11. Timmermans does not teach or suggest a memory for storing reference images in both first and second resolutions. First, Timmermans is silent about storing any "reference image." Second, Timmermans does not teach or suggest storing both first and second resolution images in a memory.

Timmermans shows the use of memory mainly for storing "control information." The playback device disclosed in Timmermans comprises "memory means which store the first control information through which said digital data base access controller controls the accessing of a digitized picture from said first digital data base and outputs display control signals." *See* Col. 4:5-8, and Abstract. Said memory may take the form of a memory module such as an electrically erasable programmable read only memory (EEPROM), e.g., a smart card or magnetic ROM cartridge, that can be extracted from the playback device and inserted into another playback device for controlling another reproduction unit, using the same picture parameter data. *See* Col. 22:5-39.

Timmermans also shows the use of memory for storing image data read from the record carrier, prior to sending it to a display device. *See* Col. 16:44-47. The only instance where Timmermans mentions the writing of multiple resolution data into a memory is related to the writing of the actual image data itself, not the storing of a reference image as recited in the independent claims of the application, and even then, the way the data is written into the memory, as disclosed by

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Timmermans, is incompatible with the requirements of the present invention. Timmermans discloses a method of storing the picture information in a picture memory "in which the picture memory 255 is first filled with picture information from a picture file defining a lower-resolution representation of a picture and subsequently the content of the memory is overwritten with a coded picture defining a higher-resolution representation of the same picture." See Col. 17:64-67 and Col. 18:1-4. In other words, the memory disclosed by Timmermans is not meant to hold both a low-resolution image and a high-resolution image, but instead to overwrite one with the other.

Applicant therefore submits that the Examiner has failed to establish a *prima facie* case of obviousness because the combination of Yonemitsu and Timmermans does not teach or suggest all the claim limitations, as recited in independent claims 1, 6, 11 and 12. Accordingly, reconsideration and withdrawal of the rejection of claims 1, 6, 11 and 12 is respectfully requested.

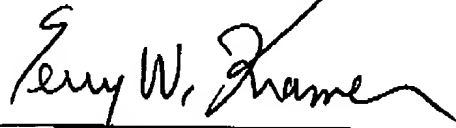
Claims 2-5 and 7-10 depend, respectively, from claims 1 and 6, and are therefore also patentable over the cited art references for at least the reasons stated above in connection with claims 1 and 6, as well as for the separately patentable subject matter recited therein. Accordingly, reconsideration and withdrawal of the rejection of claims 2-5 and 7-10 is also respectfully requested.

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While we believe that the instant amendment places the application in condition for allowance, should the Examiner have any further comments or suggestions, it is respectfully requested that the Examiner telephone the undersigned attorney in order to expeditiously resolve any outstanding issues.

In the event that the fees submitted prove to be insufficient in connection with the filing of this paper, please charge our Deposit Account Number 50-0578 and please credit any excess fees to such Deposit Account.

Respectfully submitted,
KRAMER & AMADO, P.C.



Terry W. Kramer
Registration No.: 41,541

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KRAMER & AMADO, P.C.
1725 Duke Street, Suite 240
Alexandria, VA 22314
Phone: 703-519-9801
Fax: 703-519-9802

Mail all correspondence to:
Larry Liberchuk, Registration No. 40,352
U.S. PHILIPS CORPORATION
P.O. BOX 3001
Briarcliff Manor, New York 10510
Phone: (914)333-9602
Fax: (914)332-0615